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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,375	08/26/2003	Vikki D. Shelton	P08013US00/RFH	2044

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EXAMINER

PIZIALI, JEFFREY J

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,375

Applicant(s)

SHELTON, VIKKI D.

Examiner

Jeff Piziali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 7, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>17 December 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 7, 14, and 15 are objected to because of the following informalities: Each claim uses the term "as viewed in plan." The examiner believes such language may be a typo, and suggests replacing the term with "as viewed in plane." Appropriate correction/explanation is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "generally" in claims 1, 7, and 13-15 is a relative term which renders the claims indefinite. The term "generally" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It would be unclear to one skilled in the art precisely how orthogonal or L-shaped the respective inventive parts and members must be, before they would qualify as being *generally orthogonal* or *generally L-shaped*.

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5. The term "normally" in claim 8 is a relative term which renders the claim indefinite. The term "normally" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. One skilled in the art would find it difficult to ascertain what exact operating conditions qualify as being *normal*.

6. The remaining claims 2-6, 9-12, and 16-18 are rejected under 35 U.S.C. 112, second paragraph as simply being dependent upon rejected base claims.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Usui (JP 2002222047 A -- English translation provided and referenced below).

Regarding claim 1, Usui discloses a device for, in use, preventing operation of a right operating button [Fig. 11; 2a] of a computer mouse [Fig. 11; 1], a lower edge of the right operating button being spaced from a base portion of the mouse by a gap therebetween when the right operating button is inoperative (see Figs. 1, 3, 4; Paragraph 2), and said device comprising: an operation prevention member [Fig. 5; 5] separate from the computer mouse and having an edge portion of a thickness permitting insertion of the edge portion in the gap between the lower edge of the right operating button of the mouse and the base portion of the mouse so as to prevent operation of the right operating button (see Figs. 1-4), said edge portion of the operation prevention member including a first edge part adapted to engage an end portion of the gap and a

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second edge part extending generally orthogonally to said first edge part and being adapted to engage a side portion of the gap (see Figs. 1-4; Paragraphs 10-12).

Regarding claim 2, Usui discloses the mouse includes an electrical cord [Fig. 11; wherein the PC's electrical cord (not illustrated) is operationally connected to the mouse cord 10] for connecting the mouse to a power source, and said device further comprises attachment means [Fig. 11; 10] for removably attaching the operation prevention member to the electrical cord (see Paragraphs 1-3 -- wherein a conventional mouse cord is detachable from a PC port).

Regarding claim 3, Usui discloses said attachment means [Fig. 7; where mouse cord 10 couples with the mouse housing] includes an attachment member and an elongate connecting element [Fig. 7; 10] for connecting the operation prevention member to the attachment member (see Paragraph 15).

Regarding claim 4, Usui discloses the attachment member comprises an annular member [Fig. 4; 10] having a central opening therein of a diameter that enables the electrical cord to be received in said central opening, said annular member further including a radial slit therein that enables the annular member to be fit onto the electrical cord (see Paragraph 9).

Regarding claim 5, Usui discloses said operation prevention member comprises a substantially planar member [Fig. 5; 3] (see Paragraph 10).

Regarding claim 6, Usui discloses said operation prevention member includes a gripping tab portion [Fig. 5; 4] (see Paragraphs 10-11).

Regarding claim 7, Usui discloses said operation prevention member comprises a substantially planar member [Fig. 5; 3] of a generally L-shaped configuration as viewed in plane, said L-shaped configuration including a first leg including said first edge part and a second orthogonal leg including said second edge part, said second leg further including a gripping tab [Fig. 5; 4] extending laterally outwardly therefrom in a direction away from said second edge part (see Paragraphs 10-12).

Regarding claim 8, this claim is rejected by the reasoning applied in rejecting claims 1 and 2.

Regarding claim 9, this claim is rejected by the reasoning applied in rejecting claim 3.

Regarding claim 10, this claim is rejected by the reasoning applied in rejecting claim 4.

Regarding claim 11, this claim is rejected by the reasoning applied in rejecting claim 5.

Regarding claim 12, this claim is rejected by the reasoning applied in rejecting claim 6.

Regarding claim 13, this claim is rejected by the reasoning applied in rejecting claim 1.

Regarding claim 14, this claim is rejected by the reasoning applied in rejecting claim 7.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Usui (JP 2002222047 A -- English Translation Provided).

Regarding claim 15, this claim is partially rejected by the reasoning applied in rejecting claims 1 and 7; yet Usui does not expressly teach the operation prevention member being fabricated of plastic. However, Usui does disclose modification of a conventional mouse (see Paragraphs 1-4). Furthermore, the examiner takes official notice that a conventional mouse is fabricated of plastic. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to fabricate Usui's operation prevention member out of plastic, so as to make use of an inexpensive and commonly available/relied-upon mouse fabrication material.

Regarding claim 16, this claim is rejected by the reasoning applied in rejecting claim 2.

Regarding claim 17, this claim is rejected by the reasoning applied in rejecting claim 3.

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Regarding claim 18, this claim is rejected by the reasoning applied in rejecting claim 4.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Marsac (US 2005/0219214 A1), Gray (US 2002/0196234 A1), Leman (US 6,373,468 B1), Addiego (US 6,185,964 B1), Jaaskelainen et al (US 6,115,029 A), Duchon et al (US 5,585,823 A), Kho (WO 2004012072 A1), Hayashi (WO 9512159 A1), Usui (JP 2002222046 A), Terada (JP 2002023951 A), Miwa (JP 06059808 A), and Viering (DE 29914508 U1) are cited to further evidence the state of the art pertaining to operation prevention devices for computer mice.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Piziali whose telephone number is (571) 272-7678. The examiner can normally be reached on Monday - Friday (6:30AM - 3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



26 October 2005



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